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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,873	09/23/1999	Stuart Serkin	09857/029001	5264

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EXAMINER

JAKETIC, BRYAN J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/401,873

Applicant(s)

SERKIN ET AL.

Examiner

Bryan Jaketic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5 and 7-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5 and 7-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 28 recites the limitation "the computer program" in line 1 of the claim. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests amending claim 28 to depend from claim 21.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 4, 5, 14-17, 20-22, 26, 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Korhammer et al. Korhammer et al disclose a collector facility (100) for an electronic market comprising an interface (see Fig. 2) for coupling order delivery systems (50, 51, 52, 53, and 54) to the order collector facility and a quote manager that manages quotes received at multiple price levels and a montage manager that displays an aggregate montage or a current quote montage at multiple price levels (see Fig. 5 and col. 9, lines 9-25). The interface couples the SelectNet negotiation system (604) and execution systems (see col. 5, lines 58-66). It is inherent that when an order is executed, an execution manager executes it at a single point. Korhammer et al do not disclose the use of a "sole point" of execution; however, Applicant's use of the term "single point" in the claims does not preclude the use of additional points of execution for other orders.

6. Claims 1, 7, 14, 17, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith. Smith et al disclose a collector facility for an electronic market comprising an interface for coupling Small Order Delivery Systems to the order collector facility (p. 32-34), a quote manager (p. 33, last paragraph), an order execution manager that executes orders at a single point according to price-time priority (p. 33, middle

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paragraph). It is inherent that the orders are time-stamped so that they may be filled in price-time priority. By executing orders according to price-time priority, the system is executing orders according to the nature of the participants. If a participant's nature is to place an early bid, it will be filled.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. Smith et al disclose all of the limitations of the claims except for the steps of executing against all displayed sizes of market participants in time priority, and executing any balance against displayed size of non-participants in time priority, or moving to a next price level after a predefined delay if an order is not filled. However, these are common practices in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the practice of executing against all displayed sizes of market participants in time priority, and executing any balance against displayed size of non-participants in time priority to conform to standard practice. Likewise, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the practice of moving to a

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next price level after a predefined delay if an order is not filled to conform to standard practice.

9. Claims 7, 23-25, 28, and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Korhammer et al in view of Smith et al. Korhammer et al disclose all of the limitations of the claims except for the step of executing the orders in price-time priority or according to the nature of the participants. Smith et al teach the steps of executing orders in time-price priority (p. 33, middle paragraph). It is inherent that Smith et al employ the step of time stamping the orders to fill them in time-price priority. Furthermore, the orders of Smith are thereby executed according to the nature of the participants - a participant with the nature of placing an early order will have his order executed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the method of Smith et al with the invention of Korhammer et al to execute orders in time-price priority because such a system is fair.

Regarding claim 29, neither Korhammer et al nor Smith et al disclose the steps of executing the orders or market participants first and then executing any balance against displayed size of non-participants. However, it is common in the art to give priority to market participants, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to one of ordinary skill in the art to give priority to market participants in order to follow custom.

***Response to Arguments***

10. Applicant's arguments filed 21 October 2002 have been fully considered but they are not persuasive. Applicant argues that Korhammer et al fail to show a common interface to provide a single, common point of entry for coupling order delivery systems. Examiner respectfully disagrees. Consolidating computer system (CCS) (100) provides this single, common point of entry for coupling order delivery systems (col. 6, line 51 through col. 7, line 5).

Applicant also argues that Korhammer et al fail to show an order routing/execution manager to provide a single point of delivery of executions or routing orders. Examiner respectfully disagrees. ECN1 order book server (14) routes and executes orders (col. 5, lines 58-66). ECN1 order book server (14) therefore provides a single point of delivery.

Applicant further argues that Korhammer et al do not discuss negotiation systems. Examiner respectfully disagrees. Korhammer et al utilize a SelectNet negotiation system (604).

Applicant also argues that Korhammer et al do not disclose a montage manager. Examiner again respectfully disagrees. Fig. 5 shows a montage display of multiple quotes at multiple price levels. In col. 9, lines 9-25, Korhammer et al discuss the method of displaying this montage by a montage manager.

Applicant further argues that Korhammer et al do not disclose the step of time stamping orders. Examiner concedes that Korhammer et al do not disclose this step. However, Smith et al disclose an order execution manager that executes orders at a

single point according to price-time priority (p. 33, middle paragraph). It is inherent that the orders are time-stamped so that they may be filled in price-time priority.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Jaketic whose telephone number is (703) 308-0134. The examiner can normally be reached on Monday through Friday (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone numbers for the organization where this application or proceeding is assigned are (703)



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305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

bj  
January 7, 2003

Handwritten signature of Robert P. Olszewski, dated 1/13/03.

ROBERT P. OLSZEWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600